

### REMARKS

Claims 1-80 are pending, with claims 1, 18, 23, 26, 57, 75, and 80 being independent. Claims 31-80 are being added by this amendment. No new matter is added.

Claims 1-4, 6-9, and 11-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Glenn et al. (U.S. 2002/0021307) in view of Kudoh et al. (5,948,058).

Independent claims 1, 18, 23 and 26 recite a method (claim 1), a program (claim 18), and an apparatus (claims 23 and 26) for transferring electronic data between users of a communications system that includes, among other features, delivering an e-mail message from a sender to at least one recipient and, upon opening of the e-mail message by the recipient, indicating an online state of one or more of the sender and any other recipient of the email message.

Applicant respectfully requests reconsideration and withdrawal of the rejection because Glenn and Kudoh, either alone or in combination, fail to describe at least two of the claimed features. Specifically, Glenn and Kudoh each fail to describe or suggest (1) indicating the online state of one or more of the sender and any other recipient of an electronic message, and (2) indicating such an online state upon opening of the electronic message by the recipient.

Glenn describes a method and apparatus for utilizing online presence information. See Glenn at Abstract. In rejecting independent claims 1, 18, 23, and 26, the Office Action relies upon Glenn, citing paragraphs 0021 and 0022 of Glenn, which are reproduced below:

[0021] The information retained by the presence engine is communicated to each client device in a binary fashion. When the client device receives the binary information it displays a presence indicator. The presence indicator is a cue that provides users with a way to determine what other users are connected to the network (e.g. a visual, audio, or video cue).

[0022] In one embodiment of the invention, the presence indicator is a graphic that is displayed on a web page. The graphic has multiple states and is associated with a particular user. The graphic is designed to communicate the status of the user with which the graphic is associated. In one state, the graphic indicates that a particular user is connected to the interconnection fabric. In a second state, the graphic indicates that the same user is not using the network. The presence

indicator may also be an audio or video cue configured to communicate the states discussed above. See Glenn, paragraphs 0021 and 0022.

Neither the relied upon portion, nor any other portion, of Glenn describes or suggests indicating the online state of an electronic message sender or recipient. Instead, Glenn generally discloses a presence discovery process that is employed in advance of (and is otherwise unrelated to) message sending. More specifically, according to Glenn, a first network user must initially transmit a message to a central presence engine to indicate the connectivity status of that user. See Glenn, paragraph 0067. Thereafter, when a second network user wishes to discover the connectivity status of the first user, the second user must query the presence engine which, in response, transmits a presence indicator displaying the connectivity status associated with the first user. See Glenn, paragraphs 0064 and 0067. Once the connectivity status of the first network user is transmitted from the presence engine to the second user, that second user may send to the first user a message (e.g. an e-mail) or an instantaneous communication (e.g. an instant message) based upon the connectivity status of the first user. See Glenn, paragraphs 0056 and 0059.

While the Glenn process involves providing a potential message sender with information regarding the online status of a potential recipient, it does not involve providing presence indicators within messages that have been sent and received. Accordingly, neither the relied upon portion, nor any other portion, of Glenn describes or suggests indicating the online state of a sender and/or recipient(s) upon the opening of an electronic message by the recipient.

Furthermore, Glenn suggests that the first and second network users are a potential recipient and a potential sender of a potential message, respectively, but fails to disclose provision of online status indicator(s) for the sender and any other recipient of a message that has been sent in accordance with independent claims 1, 18, 23, and 26.

Kudoh describes an e-mail cataloging and retrieving system to facilitate the classification of numerous e-mails with minimal time and effort. See Kudoh, Abstract and col. 3, lines 30-35. Although Kudoh teaches delivery of an e-mail from a sender to at least one recipient, Kudoh is not relied upon, and in fact, fails to remedy the shortcomings of Glenn, which are discussed

above. Specifically, Kudoh does not remedy the failure, by Glenn, to describe or suggest (1) indicating the online state of one or more of the sender and any other recipient of an electronic message and (2) indicating such an online state upon opening of the electronic message by the recipient, as recited in independent claims 1, 18, 23, and 26.

Accordingly, Applicant respectfully asserts that the prior art references relied upon by the Examiner fail to teach or suggest all of the claim limitations recited by independent claims 1, 18, 23, and 26. For this reason, *inter alia*, Applicant asserts that a *prima facie* case of obviousness has not been established with regard to the independent claims. Applicant therefore respectfully requests reconsideration and withdrawal of the §103(a) rejection of independent claims 1, 18, 23, and 26, and their respective dependent claims 2-4, 6-9, 11-17, 19-22, 24, 25, and 27-30.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Glenn in view of Kudoh and further in view of Bezos (6,525,747). As discussed above with respect to amended independent claims 1, 18, 23, and 26, Glenn and Kudoh, either alone or in combination, fail to describe or teach the features in the independent claims. Bezos fails to remedy the Glenn and Kudoh shortcomings. For at least this reason, and based on its dependency from independent claim 1, Applicant respectfully requests withdrawal of the rejection of claim 5.

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Glenn in view of Kudoh, and further in view of Bunney et al. (6,446,112). As discussed above with respect to amended independent claims 1, 18, 23, and 26, Glenn and Kudoh, either alone or in combination, fail to describe or teach the features in the independent claims. Bunney fails to remedy the Glenn and Kudoh shortcomings. For at least this reason, and based on its dependency from independent claim 1, Applicant respectfully requests withdrawal of the rejection of claim 10.

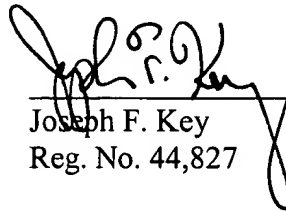
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Enclosed is a \$1158.00 check for excess claim fees. During presentation of this application, please apply any deficiencies or credits to deposit account 06-1050.

Respectfully submitted,

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